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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,508	07/23/2002	Naoyo Isoda	SIMTEK6265	6620
25776	7590	12/01/2003	EXAMINER	
ERNEST A. BEUTLER, ATTORNEY AT LAW 10 RUE MARSEILLE NEWPORT BEACH, CA 92660			LEWIS, TISHA D	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/064,508

Applicant(s)

ISODA ET AL.

Examiner

TISHA D. LEWIS

Art Unit

3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

### **DETAILED ACTION**

The following is a response to the amendment received on November 12, 2003, which has been entered.

#### ***Response to Amendment***

Claims 1-20 are pending in the application.

-The claim objection of claims 10 and 12 has been withdrawn due to the amendment correcting typographical errors as indicated in the office action mailed on August 13, 2003.

-The 102(b) rejection of claims 1-3, 5, 7, 8 and 11 has not been withdrawn as requested by applicant (see response to arguments below).

-The 103(a) rejection of claims 4, 10 and 12-16 has not been withdrawn due to the 102(b) rejection still being applied to the above claims.

-The double patent rejection of claims 1-9, 11 and 13-20 has not been withdrawn as requested by applicant (see response to arguments below).

-Claims 6, 9 and 17-20 were indicated as having allowable subject matter.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7, 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwata et al ('399). As to claims 1, 5 and 11, Iwata et al discloses an

Art Unit: 3681

engine control method including an engine (10) transmitting rotation to driven wheels (18, 19) through a transmission (11) wherein an engine speed is monitored (39) according to variation between an acceleration and deceleration condition to reduce engine speed for reducing engine output if the engine speed becomes greater than a predetermined speed to control excessive wheel slippage.

As to claims 2 and 3, Iwata et al discloses the engine speed being measured on every predetermined engine cycle pertaining to crank angle (portion of shaft rotation) and crank position.

As to claims 7 and 8, Iwata et al discloses the engine output also being varied by a spark timing (column 8, lines 50-53) which usually has a set timer.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata et al in view of Ito ('951). Iwata discloses an engine having successive cycles, but does not disclose the type of engine cycle.

Ito discloses an engine control method for restricting engine output if engine speed is excessive wherein the engine is a four cycle having any operating principle (compression and exhaust cycle).

Art Unit: 3681

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the engine of Iwata et al with a four cycle in view of Ito to prevent over speeding of the engine.

Claims 10, 12-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata et al in view of Sato et al ('674). As to claims 10 and 12, Iwata et al discloses a transmission, but does not disclose if a clutch is used.

Sato et al discloses a transmission control having a clutch wherein an engine speed (input clutch pressure) is reduced to reduce judder/vibration of the transmission.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide Iwata with a vibration/judder control for a clutch/transmission in view Sato et al to eliminate degrade of vehicle drive comfort for the operator.

As to claims 13 and 14, Iwata et al discloses the engine speed being measured on every predetermined engine cycle pertaining to crank angle (portion of shaft rotation) and crank position.

As to claim 16, Iwata discloses the engine speed being monitored (39) according to variation between an acceleration and deceleration condition.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata et al in view of Sato et al as applied to claim 14 above, and further in view of Ito. Iwata discloses an engine having successive cycles, but does not disclose the type of engine cycle.

Art Unit: 3681

Sato discloses an engine having successive cycles, but does not disclose the type of engine cycle.

Ito discloses an engine control method for restricting engine output if engine speed is excessive wherein the engine is a four cycle having any operating principle (compression and exhaust cycle).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the engine of Iwata et al and Sato et al with a four cycle in view of Ito to prevent over speeding of the engine.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 11 and 13-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/064,507. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim an engine control having an engine transmitting rotation to driven wheels through a transmission

Art Unit: 3681

system and detecting during engine acceleration variations in the rotational state of a shaft if the degree of change in the variation of the shaft is excessive and restricting an engine output if the change is excessive.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

Applicant's arguments filed November 12, 2003 have been fully considered but they are not persuasive.

Applicant's argument that the co-pending application 10/064,507 and the present invention is patentably distinct has been taken into consideration for overcoming the double patent rejection. However, changing the pre-amble of the claims in the present invention does not change the scope of the claim limitations. In fact, being that both applications claim an engine control method for restricting engine output according to excessive shaft variation, etc., it would be difficult to provide a reason for proper restriction between the two. Therefore, the double patent rejection is still deemed proper and according to applicant's argument, the co-pending application claims are considered generic to the present invention claims. When the co-pending application is patented/published, this rejection may be changed to a non-provisional double patent rejection if a terminal disclaimer is not filed.

Applicant states that the claims have been amended to address the Examiner's 112 rejection, but a 112 rejection was not made in the office action mailed on August 12, 2003.

Art Unit: 3681

Applicant's argument that the Iwata et al ('399) reference is directed to wheel slip control and one of ordinary skill in the art would not look to this field for a solution to the present problem has been considered. The examiner agrees that the Iwata et al reference is directed to wheel slip control, but Iwata et al does use engine parameter control (speed, acceleration, deceleration) to control the wheel slippage. In order to control the wheel slippage, the engine parameter control has to be used before the wheel slippage control can work, in other words, if the wheel slippage control wasn't a motivation for the Iwata et al reference, then the engine control variation between the acceleration and deceleration would still be operable to restrict engine output. Therefore, it is believed that one of ordinary skill in the art would look to any field that provides restriction of engine output for control of engine acceleration. Examiner suggest applicant amend claims 1 and 11 according to the allowable subject matter of claims 6, 9 and 17.

#### ***Allowable Subject Matter***

Claims 6, 9 and 17-20 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and upon filing of a terminal disclaimer as stated above in the double patent rejection.

#### **FACSIMILE TRANSMISSION**

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission,



Art Unit: 3681

see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to  
the Patent and Trademark Office (Fax No. (703) 000-0000) on \_\_\_\_\_ (Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_

\_\_\_\_\_

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3681


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 703-305-0921. The examiner can normally be reached on M-Thur 8 AM TO 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

Tdl  
November 26, 2003

  
Tisha D Lewis  
Patent Examiner  
AU 3681 11-26-03